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PTO/SB/92 (09/04)

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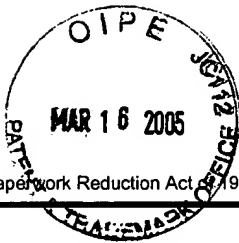
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Confirmation No.: 9219

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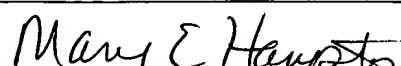
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/391,869
	Confirmation No.:	9219
	Filing Date	September 8, 1999
	First Named Inventor	Smith, Mary
	Art Unit	3722
Examiner Name		Henderson, Mark T.
Total Number of Pages in This Submission	Attorney Docket Number	83317.000004

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal <input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> After Allowance communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
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Firm or Individual name	Brian B. Shaw, 33,782 HARTER, SECREST & EMERY LLP
Signature	
Date	March 14, 2005

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PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Smith, Mary	Atty. Docket:	83317.000004
Serial No.:	09/391,869	Examiner:	Mark T. Henderson
Filed:	September 8, 1999	Art Unit:	3722
Title:	POCKET INSERT FOR BOUND BOOK		

Reply Brief Pursuant to 37 C.F.R. §1.193

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Sir:

With respect to the Examiner's Point No. 1, Appellant knows of no related appeal or interference which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal.

Appellant takes issue with one statement made by the Examiner at his Point 11 regarding Appellant's argument as to the propriety of the rejection of Claim 35 under 35 U.S.C. 102. In Appellant's brief, the argument was made that there is no support in the reference (Michlin, US 5,141,252) for the assertion that the insert of the reference "is printed after assembly". The Examiner at page 5, lines 1-5, states that "this feature is not recited in the claims" and further that "Appellant does not disclose in the claims whether the insert is inserted in the printer/copier before or after it has been assembled".

The quoted passage of Appellant's brief was there to make the point that whereas Claim 35 recites a limitation that the insert *per se* is of a thickness rendering it passable through a copier, there is no clear teaching in the reference that its insert has the same thickness property. Appellant's point was that since the reference did not teach an insert of the recited thickness the rejection under U.S.C. 102 could not stand.

Appellant further takes issue with the Examiner's position that the claims do not disclose whether the insert is inserted into the printer/copier "before or after it has been assembled." Whether the insert is inserted into a printer/copier before or after assembly is not material to the issue of whether the claimed insert (comprising the sheets and adhesive as recited in Claim 35) has the thickness as recited in the Claims. Moreover, independent Claims 32 and 34-36 all recite that the insert (that is, the article claimed) has a thickness rendering it passable through a printer/copier "in sequence with a sheet of paper." From this language, it is at least implicit that the claimed insert can be inserted into the printer/copier after assembly.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Roger Aseto", written over a horizontal line.

Roger Aseto, Registration No. 24, 554
HARTER, SECREST & EMERY LLP
1600 Bausch & Lomb Place
Rochester, New York 14604
(585) 232-6500

Date: March 10, 2005